

REMARKS/ARGUMENTS

I. Claim Rejections under 35 U.S.C. § 102(e) as being anticipated by Parce et al.
(US 6,046,056)

Claims 1–12 and 16–23 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,046,056 (“Parce”). “[F]or anticipation under 35 U.S.C. § 102, a single reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.” MPEP § 706.02. “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, USPQ2d 1913, 1920 (Fed. Cir. 1989).

As previously argued, the type of separation described in the instant application is not the same as that taught by Parce. By the same token, the type of separation region described in the instant application is not the same as that taught by Parce. Therefore, at a minimum, Parce does not teach “a first microscale channel comprising a gel filled component separation region.” Further, Parce is silent with respect to “a first detection region within the first channel.”

As described by Applicants on page 10, paragraph 0044 lines 2–9, “The devices typically include a separation channel for separating a sample mixture into its various components. For example, a mixture of proteins as it flows through the separation channel or separation region will be separated into separated proteins. Preferably, the separation channel is a gel filled channel . . . that separates the various components based on molecular weight, wherein each component is eluted from the separation channel with a different retention time. In this embodiment, the components are then optionally detected and their molecular weights determined by the retention time.” See also page 12, paragraph 0051 lines 4–6 and pages 18 and 19, paragraphs 0077 and 0078.

While Applicants’ “component separation region” separates a sample into its component parts and retains one or more **components of interest**, the “particle retention zone” of Parce separates and retains **unwanted particulate material**, such as cell debris or carrier beads, and allows the material of interest to flow beyond the “particle sieving or filtration matrix.” See Parce column 18, lines 9–14, and column 17, lines 58–61.

That the “particle retention zone” of Parce retains unwanted material rather than the analyte of interest is made clear by reading U.S. Patent No. 5,304,487 (“Wilding”), which is cited

by Parce in column 18, lines 15–17, and incorporated by reference. Wilding teaches as follows: “Cell debris may be filtered off using a filter microfabricated in the flow system downstream from the cell lysis means.” See Wilding column 6, lines 52–54. “The filtrate exits through the filter 80 into channel 20B, prior to subsequent downstream analysis in, e.g., a mesoscale detection region.” See Wilding column 7, lines 56–59. Thus the “filtrate,” defined by *Merriam-Webster’s Online Dictionary, 10th Edition*, as “fluid that has passed through a filter,” contains the analyte, i.e., the component of interest.

By referring to FIGS. 4E and 4F of Parce, one can see the “soluble signal 356” (i.e., the material or components of interest) flowing out of the channels containing particle retention zones 344 and into a separate channel. This is described by Parce in column 19, lines 42–45: “In FIGS. 4E and 4F, the soluble signal is then flowed out of reaction channels 312–324 into the detection channel 308, and along the detection channel past the detection window 116.”

This passage also illustrates that Parce does not teach “a first detection region within the first channel.” As can be seen in FIGS. 4E and 4F, the detection region of Parce (detection window 116) is not within the same channel as any of the particle retention zones 344.

Thus, Parce does not teach every aspect of the claimed invention either explicitly or impliedly. Nor does Parce show the identical invention in as complete detail as is contained in Applicants’ independent claim 1. Withdrawal of the rejection of claim 1 under U.S.C. § 102(e) as being anticipated by Parce (US 6,046,056) is, therefore, respectfully requested.

Claims 2–12 and 16–23 depend directly or indirectly from independent claim 1. Therefore, Applicants respectfully submit that these dependent claims are allowable for at least the same reasons as set forth herein with respect to independent claim 1. Withdrawal of the rejection of dependent claims 2–12 and 16–23 under U.S.C. § 102 (e) as being anticipated by Parce (US 6,046,056) is also respectfully requested.

II. Claim Rejections under 35 U.S.C. § 103(a) as being unpatentable over Parce et al. (US 6,046,056) in view of Nilsson (US 5,405,752)

Applicants’ previous argument is repeated verbatim below. Applicants call the Examiner’s attention to the fact that 35 U.S.C. § 103(c) specifically addresses references applied to the instant filed application under § 102(e), as well as under §§ 102(f) and 102(g). Thus, the Examiner’s statement that Parce has been applied to the instant filed application under § 102(e)

requires disqualification of Parce as a § 103(a) reference. Applicants refer the Examiner to the text of 35 U.S.C. § 103(c), cited below for the Examiner's convenience.

Claims 13–15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parce in view of U.S. Patent No. 5,405,752 (“Nilsson”). Applicants respectfully traverse this rejection because 35 U.S.C. § 103(c) disqualifies Parce from being used as prior art for an obviousness rejection. 35 U.S.C. § 103(c), effective November 29, 1999, provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of Section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103(c) applies to all applications filed on or after November 29, 1999 including continuing applications (may be continuations, divisionals, or continuations-in-part) filed under 37 CFR 1.53(b). MPEP Section 706.02(k).

The instant application was filed on July 2, 2003 as a continuing application under 37 CFR 1.53(b), so the provisions of 35 U.S.C. § 103(c) apply. Under 35 U.S.C. § 103(c), a reference which qualifies as prior art only under 35 U.S.C. § 102(e) (in addition to §§ 102(f) or (g)) and that is commonly owned, or subject to an obligation of assignment to the same person, at the time the invention was made cannot be applied in a rejection under 35 U.S.C. § 103(a). In the present case, the Examiner's § 103(a) rejection primarily relies on the Parce reference, which was filed on December 6, 1996, and which issued on April 4, 2000. Since the present application claims priority to U.S. Provisional Application No. 60/150,293, which was filed on August 26, 1999, the Parce reference only qualifies as prior art under § 102(e) (and/or § 102(f) or (g)). In addition, both the instant application and the Parce reference were commonly owned by the same present assignee, Caliper Technologies Corp. (now Caliper Life Sciences, Inc.), at the time the claimed invention of the present application was made. Accordingly, the Parce reference cannot be applied in a rejection under 35 U.S.C. § 103(a) under the provisions of 35 U.S.C. § 103(c). Therefore the obviousness rejection of claims 13–15 based on the combination of Parce and Nilsson is moot.

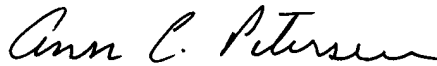
Further, as shown above, Parce does not teach all of the limitations of Applicants' independent claim 1. Therefore, independent claim 1 is nonobvious. Claims 13–15 depend directly from independent claim 1. Any claim depending from a nonobvious claim is also nonobvious. *See*

MPEP § 2143.03 and *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 13–15 are nonobvious.

Conclusion

For the foregoing reasons, Applicants believe all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned attorney.

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Signed: _____

